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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,051	06/20/2001	Yoshiki Kawaoka	3562-0117P	2692
2292	7590	03/24/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			VILLECCO, JOHN M	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/884,051

Applicant(s)

KAWAOKA ET AL.

Examiner

John M. Villecco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 and 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,10,11,20,21,23,28,29 and 38 is/are rejected.
- 7) ☒ Claim(s) 5-9 and 24-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/20/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1, 2, 4-12, 20, 21, 23-30, and 38 in the reply filed on November 3, 2004 is acknowledged. The traversal is on the ground(s) that the examiner has failed to meet the burdens set forth in MPEP § 803.1. This is not found persuasive because MPEP § 803.1 is directed toward making a restriction requirement. In the action sent out on October 4, 2004, an election of species requirement was made, not a restriction requirement. The burdens set forth in MPEP § 803.1 only apply to restriction requirements.

The requirement is still deemed proper and is therefore made FINAL.

Additionally, after a review of claims 12 and 30 it appears that the limitation of the predetermined transmission allowance condition including a condition where a number of the photo images reaches a predetermined number, can only be found in the second embodiment which is directed towards Figure 5. Therefore, since claims 12 and 30 are directed towards a non-elected species they will not be examined.

In order to clarify the examiner's position, claims 1 and 20 are only generic to the first and third embodiments. Additionally, there is no disclosure in the specification of an embodiment in which the limitations of claim 1, along with the limitations of the second embodiment. If applicant were to pursue the second embodiment based on claim 1, some 112, 1<sup>st</sup> paragraph issues would come up.

Claims 3, 12-19, 22, and 30-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or

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linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 3, 2004.

### *Claim Objections*

2. Claim 6 is objected to because of the following informalities:

- In line 9 of claim 6, applicant claims that the photo images are calculated by a **data amount**. This is unclear. It appears that applicant mean to say that the photo images are calculated by a **data amount-obtaining section**.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

4. **Claims 1, 20, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Koide (Japanese Publ. No. 2000134531-A).**

5. Regarding *claim 1*, Koide discloses a camera (100) which operates to interrupt image transmission when it is detected that an image capture operation has been initiated. More specifically, the camera includes communication link interface circuitry (112) for transmitting images to a computer (113). The communication link interface circuitry is interpreted to be the transmission section. A system controller (115) is connected to the communication line interface circuitry (112) and since it controls the operation of the camera, it would inherently judge whether or not a switch (SW1 or SW2) has been depressed for initiating an image capture.

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Therefore, the system controller (115) is interpreted to be the transmission control unit.

Furthermore, when it is determined that the image capture is completed, image transmission is again allowed. See the abstract. An Official translation of this reference has been ordered for use in subsequent office actions.

6. *Claim 20* is considered a method claim corresponding to claim 1. Please see the discussion of claim 1 above.

7. As for *claim 38*, Koide discloses interrupting the image transfer if it is determined that a switch is activated. In order for this to occur, the camera has to be transmitting image data and the switch has to be depressed. Therefore, the judging is based on a plurality of conditions.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 2 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Koide (Japanese Publ. No. 2000134531-A) in view of Tamura et al. (U.S. Application Publ. No. 2004/0169730 A1).**

10. Regarding *claim 2*, as mentioned above in the discussion of claim 1, Koide discloses all of the limitations of the parent claim. However, Koide fails to explicitly disclose a battery, wherein the storage level of the battery is used a predetermined transmission allowance condition. Tamura, on the other hand, discloses camera that checks the battery level of the

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camera before transmitting images in order to determine if enough battery power is left for a successful transmission. More specifically, as shown in Figures 9 and 10 and discussed in paragraphs 0197-0201, Tamura discloses determining the number of sheets for transmission, then checking the battery to determine how many sheets can successfully be transmitted. If the number of sheets to be transmitted is more than the number of sheets that can successfully be transmitted using the battery, then transmission of the images does not occur. If the amount of battery is sufficient then the transmission of the images to the printer is allowed. Additionally, Tamura discloses that instead of calculating the number of sheets to be transmitted, the number of bytes to be transmitted can be used. This feature allows for the successful transmission of image data based on the battery power left. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine if the amount of battery left in Koide is sufficient for the successful transfer of images to the computer.

11. *Claim 21* is considered a method claim corresponding to claim 2. Please see the discussion of claim 2 above.

12. **Claims 4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koide (Japanese Publ. No. 2000134531-A) in view of Iizuka (Japanese Publ. No. 09-288684 A).**

13. Regarding *claim 4*, as mentioned above in the discussion of claim 1, Koide discloses all of the limitations of the parent claim. However, Koide fails to explicitly disclose transmitting data depending on a timer. Iizuka, on the other hand, discloses that it is well known in the art to transmit images based on a set schedule. More specifically, Iizuka discloses a method of posting

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updated images on a website. The system includes image gathering terminals (1a-1d) and an image collection terminal (3). When a timer indicates that it is time to collect images the image collection terminal calls the image gathering terminals and requests images. This feature allows for a continuously updated image stream viewable over a network. Therefore, it would have been obvious to incorporate a system within the camera of Koide that transmits images a specified times of the days so that an updated image is continuously presented over a network. An official translation of this reference has been ordered for use in subsequent office actions.

14. *Claim 23* is considered a method claim corresponding to claim 4. Please see the discussion of claim 4 above.

15. **Claims 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koide (Japanese Publ. No. 2000134531-A) in view of Morimoto et al. (U.S. Patent No. 6,774,935).**

16. Regarding *claim 10*, as mentioned above in the discussion of claim 1, Koide discloses all of the limitations of the parent claim. However, Koide fails to explicitly disclose a release switch for controlling which images to transfer after capturing the images. Morimoto, on the other hand, discloses a camera which is capable of transmitting the images out of the camera, based on whether or not an image has been selected to be transferring. More specifically, as disclosed in column 9, lines 45-53 Morimoto discloses selecting an image to be transmitted using the UP switch (6) and the DOWN switch (7). When the shutter button (9) is depressed the selected image will be transferred. This features serves as an effective way of selecting an image to transmit. Since it is not yet clear whether or not Koide discloses this feature, it would have

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been obvious to one of ordinary skill in the art at the time the invention was made to include a release switch (shutter button) for selecting an image to be transmitted so that additional buttons do not have to be added to the camera body, thus cluttering the surface of the camera.

17. *Claim 28* is considered a method claim corresponding to claim 10. Please see the discussion of claim 10 above.

18. **Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koide (Japanese Publ. No. 2000134531-A) in view of Safai (U.S. Patent No. 6,715,003).**

19. Regarding *claim 11*, as mentioned above in the discussion of claim 1, Koide discloses all of the limitations of the parent claim. However, Koide fails to explicitly disclose an addressee registration section for registering a phone number of an addressee for transmitting the photo images. Safai, on the other hand, discloses that it is well known in the art to register the destination information of an image to be transmitted. More specifically, as disclosed in column 8, line 37 to column 9, line 20, a user is able to enter a destination email address or select a destination email address from a list. Additionally, Safai discloses that the address does not have to specifically be an email address. The address can also be a phone number (col. 10, line 54). This feature allows a user to select a destination address to associate with an image that is to be transmitted. Thus, a user can transmit an image to any user who they decide. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a user to register a phone number of a destination user in the camera of Koide so that user has control over who the image data is to be transmitted.



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20. *Claim 29* is considered a method claim corresponding to claim 11. Please see the discussion of claim 11 above.

***Allowable Subject Matter***

21. Claims 5-9 and 24-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

22. The following is a statement of reasons for the indication of allowable subject matter:

Regarding *claims 5 and 24*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the transmission control unit notifies a user of a period of time to an end of the predetermined time range, based on the time obtained by the time obtaining section.

As for *claims 6 and 25*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the predetermined transmission allowance condition includes a condition when a cost for transmitting the photo images calculated by the data amount-obtaining section is within a predetermined range.

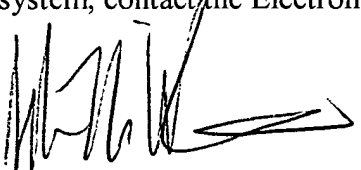
With regard to *claims 9 and 27*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the predetermined transmission allowance condition includes a condition when a remaining time for transmitting said photo images is shorter than a predetermined time, in a case where a cost for a transmission is calculated based on unit communication time.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (703) 305-1460 (Crystal City) or (571) 272-7319 (Carlyle). The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929 (Crystal City) or (571) 272-7308 (Carlyle). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco  
March 13, 2005



WENDY R. GARBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600